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| APPLICATION NO.                | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|--------------------------------|-------------|----------------------|----------------------|------------------|
| 10/601,226                     | 06/20/2003  | Robert F. Burkholder | JK01507A             | 9184             |
| 28268                          | 7590        | 05/04/2007           | EXAMINER             |                  |
| THE BLACK & DECKER CORPORATION |             |                      | FREAY, CHARLES GRANT |                  |
| 701 EAST JOPPA ROAD, TW199     |             |                      | ART UNIT             | PAPER NUMBER     |
| TOWSON, MD 21286               |             |                      | 3746                 |                  |
| MAIL DATE                      |             | DELIVERY MODE        |                      |                  |
| 05/04/2007                     |             | PAPER                |                      |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/601,226             | BURKHOLDER ET AL.   |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Charles G. Freay       | 3746                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 March 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 and 17-67 is/are pending in the application.  
 4a) Of the above claim(s) 3-7,10,12,22,24 and 27-35 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2,8,9,11,13-15,17-21,23,25,26 and 36-65 is/are rejected.  
 7) Claim(s) 66 and 67 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

This office action is in response to the Amendment of March 5, 2007 filed with the Request for Continued Examination.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 62 is recites the limitation "electric motor" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 36, 37, 40, 41, 51-53, 56, 64 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Ushiota et al (USPN 5,030,067).

Ushiota et al disclose a hand portable air compressor (see Fig. 8), having a air tank (46), a compressor (44), a shroud (82) substantially enclosing the compressor and the tank, and the shroud having a handle (84) and a base (either the lower portion of Fig. 8 or the side (with members 86, 88). Furthermore there is a pressure regulator (72)

and a gauge (70) and tubing (68) clearly disclosed throughout the figures. There is additionally a motor (42) that drives the air compressor. The tank has first (where line 68 enters the tank) and second (just above the leader line for reference numeral 46 in Fig. 8) access ports.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 2 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ushio et al.

As set forth above Ushio et al discloses the invention substantially as claimed but does not disclose that the tank is unpainted. Ushio et al makes no mention of the tank being painted or unpainted. Therefore, the tank is either already unpainted or it would have been obvious to one of ordinary skill in the art to not paint the tank since the tank is going to be covered by the shroud. Painting the tank would only increase the manufacturing cost to add an aesthetic appeal to the tank that is going to be covered by the shroud and unseen anyways.

Claims 8, 9, 11, 13, 14, 15, 17, 18, 20, 21, 23, 25, 26, 38, 39, 42-50, 54, 55, 57-61 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ushio et al in view of Beckman et al (USPN 6,991,436).

As set forth above Ushio et al discloses a shrouded hand portable air compressor substantially as claimed but does not disclose that the tank is made of metal or steel, that the shroud is made of plastic, that the motor is an electric motor or an internal combustion engine, that the housing is made as a clamshell which supports the elements within it, and further does not clearly disclose a control panel. Beckman et al discloses an air compressor system having a tank which is made of steel (a metal) (col. 1 lines 26 and 27), a clam shell shroud, made of plastic (col. 5 line 46) that supports the elements therein (see col. 2 lines 45-48 and Figs. 4 and 5), as sets forth in the first full paragraph of col. 4 that the motor can be either an electric motor or an

internal combustion engine, and there is a control panel clearly disclosed at the bottom portion of Fig. 3 near (74, 76, 78). At the time of the invention it would have been obvious to one of ordinary skill in the art to make the generically disclosed shroud of Ushioita et al as a disclosed by Beckman et al to be of plastic material in order to provide lightness and durability to the Ushioita et al shroud (note the sentence spanning cols. 3 and 4 of Ushioita et al) while providing a firm support for all of the elements therein. It also would have been obvious to make the tank of metal or steel as a well known and durable material for tanks. It also would have been obvious to locate one of the access ports near a bottom depending upon how the final design and layout of the structure is with relation to the device which will be provided compressed air.

With regards to claim 20, Ushioita et al makes no mention of the tank being painted or unpainted. Therefore, the tank is either already unpainted or it would have been obvious to one of ordinary skill in the art to not paint the tank since the tank is going to be covered by the shroud. Painting the tank would only increase the manufacturing cost to add an aesthetic appeal to the tank that is going to be covered by the shroud and unseen anyways.

With regards to claim 14 the examiner notes that official notice was taken in each of the previous office actions that tanks having a single access port, with associated valving being outside the tank are well known. Because the applicant has not challenged this position it is taken as an admission that this limitation is admitted prior art. At the time of the invention it would have been obvious to one of ordinary skill in the art to substitute such a single access port arrangement for the two port arrangement of

the tank shown in Ushiota et al in order to reduce the tubing required and the number of air access ports.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ushiota et al in view of Beckman as applied to claim 18 above, and further in view of Moynihan et al (USPN 4,712,983).

As set forth above Ushiota et al in view of Beckman et al discloses the invention substantially as claimed but does not disclose the first and second air access ports being arranged at the top and bottom of the tank. Moynihan discloses an air compressor and tank system having a tank with first and second access ports at opposite ends thereof (Fig. 2). At the time of the invention it would have been obvious to one of ordinary skill in the art to substitute a tank having the ports arranged at opposite ends of the tank as disclosed by Moynihan in order to create, and dependant upon, the required spacing and footprint for the device as a whole and the desired connection to the output of the device.

#### ***Allowable Subject Matter***

Claims 66 and 67 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

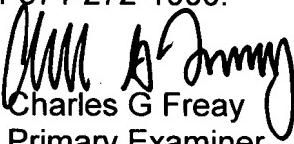
Applicant's arguments filed March 9, 2007 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles G. Freay whose telephone number is 571-272-4827. The examiner can normally be reached on Monday through Friday 8:30 A.M. to 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571-272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Charles G Freay  
Primary Examiner  
Art Unit 3746

CGF  
April 27, 2007